PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of	Docket No: Q86527
Eiji TSURU, et al.	
Appln. No.: 10/526,898	Group Art Unit: 1626
Confirmation No.: 7841	Examiner: KOSACK, JOSEPH R.
Filed: March 7, 2005	

For: CRYSTAL FOR ORAL SOLID DRUG AND ORAL SOLID DRUG FOR DYSURIA TREATMENT CONTAINING THE SAME

FIRST RESPONSE FOR RCE

MAIL STOP AMENDMENT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Review and reconsideration on the merits are requested.

REQUEST FOR TELEPHONE INTERVIEW

Applicants respectfully request a telephone interview concerning this application.

If the Examiner would require any additional supporting material, for example, a full translation of Literature 1 or any other information to advance prosecution, Applicants respectfully request this be discussed at the telephone interview.

Discussion

Applicants appreciate the Examiner withdrawing the previous claim rejections under 35 U.S.C. § 103 and on grounds of obviousness double patenting.

However, the Examiner has posed a new rejection, namely that claims 1-18, all claims, are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

The Examiner has cited the *Wands* factors, and correctly points out that *Wands* does recite a number of factors which may be considered in determining whether a disclosure meets the enabled requirement of 35 U.S.C. § 112, first paragraph.

The Examiner has focused on certain of the *Wands* that Applicants wish to discuss.

The Examiner makes the following statements in the Action:

"The basis for showing that the prior art process does not produce the alpha form is that a different process of making the compound was used in the instant application, which was not disclosed originally and was disclosed in the Declaration. There is no evidence as to when, if ever, the process was publicly disclosed before, therefore it must be currently assumed that this is the first disclosure of the instant process.

* * *

The written description states that the alpha form can be made by dissolving crude crystals in heated ethyl acetate and allowed to stand at room temperature. The description does not state how the crude crystals were obtained.

* * *

One of skill in the [art] would have had to come up with the process for making the compound that was kept secret, in order to generate the proper crude crystals referred to in the Examples in the specification."

Traversal

Applicants submit that the present specification does enable one of ordinary skill in the art to practice the invention. It is believed that the Examiner's basic position is that the two Declarations executed by Eiji Tsuru, one on December 18, 2006 and one on June 6, 2006 (these are the execution dates; the filing dates were December 27, 2006 and June 13, 2006) essentially establish that a different process of making the compound was used in the present application which was not disclosed originally and was disclosed in the Declaration, there is no evidence as to when, if ever, the process was publicly disclosed before, and therefore, it must be currently assumed, that this is the first disclosure of the instant process.

What the Present Specification Does Disclose

As background, the present invention, as the Examiner appreciates (Action, page 4, *The Nature of the Invention*, is the alpha form of the compound currently known as KMD-3213, along with medicaments and a method of using the crystal.

The present application was published as U.S. 2006/0142374A1 on June 29, 2006. This is referred to here as '374.

In fact, the present specification at page 9, lines 2-5, corresponding to the '374 publication at [0034] disclosed:

"KMD-3213 represented by the above formula (I), which is comprised as an active ingredient in the oral solid medicament of the present invention, **is a known compound** and, for example, can be prepared by the procedure described in the above Literature 1." (bolding added)

Applicants advise that Literature 1, which is JP HO 6-220015, has as a family member U.S. 5,387,603 Kitazawa et al ('603) which the Examiner, of course, is well aware of, having

used '603 to support an obviousness rejection of claims 2-7 in combination with Yamagishi et al (JP 07-330726A) in view of Williamson (Macroscale and Microscale Organic Experiments 1999, pages 39 and 48-50); for instance, see the Action of July 27, 2006 at page 2, last full paragraph.

Since '603 was available as prior art well prior to the filing date of the present application or any earlier benefit case it is every bit as valuable as Literature 1 on the issue of enablement. See *Glass, infra* and *In re Scarbrough*, 500 F.2d 560, 182 USPQ 298 (CCPA) 1974).

It is further disclosed in the present specification at page 2, lines 1-9, which corresponds to the '374 publication at paragraph [0004] as follows:

"It is known that KMD-3213 comprising as an active ingredient in the oral solid medicament for dysuria treatment of the present invention has a selective suppression effect of the urethra smooth muscle contraction and is an extremely useful compound as the medicament for dysuria treatment which does not cause a strong hypotensive effect or orthostatic hypotension. However, its concrete detailed preparing method **and** purification method have not been reported." (bolding added)

Literature 1 is disclosed in the present specification at page 2, line 35 to page 3, line 5, corresponding to paragraph [0007] of the '374 publication, as follows:

"That is, up to the present, preferable crystal forms like the present invention of KMD-3213 for a solid medicament and an oral solid medicament for dysuria comprising the same are not reported nor suggested at all.

Literature 1: Japanese unexamined publication HO6-220015

Literature 2: Japanese unexamined publication 2001-288115"

The present specification further disclosed at page 4, lines 10-13, corresponding to part of paragraph [0014] of the '374 publication, as follows:

"The present inventors have found a novel crystal form suitable for oral solid medicaments. Based on the founding, the present invention has been accomplished."

As explained in the present specification at page 5, lines 11-22, corresponding to paragraph [0019] of the '374 publication, KMD-3213 has at least three crystal forms shown by powder X-ray diffraction patterns as in Fig. 1 to Fig. 3, namely the α, β and γ forms. As disclosed in the present specification at page 5, line 24-page 6, line 7, corresponding to paragraphs [0020], [0021] and [0022] of the '374 publication, which also give preparation procedures.

The present specification at page 11, line 20 over to page 12, line 11, corresponding to paragraphs [0044], [0045] and [0046] of the '374 publication, gives working examples as to how to prepare the crystal form α, the crystal form β and the crystal form γ.

The solvents used in preparing these forms were ethyl acetate (crystal form α), methanol/petroleum ether (crystal form β) and toluene (crystal form γ). These procedures used in the working Examples parallel the disclosure in the specification at page 5, line 24 - page 6, line 7, corresponding to paragraph [0020] - [0022] of the '374 publication.

The present application thus teaches how to make what might be viewed as the starting material for the desired α crystal. Note in the Examples the starting materials is "crude crystals of KMD-3213", namely from '603, family member of Literature 1 (present specification, page 9, lines 2-5 and at page 3, line 4).

Applicants now turn to '603.

Discussion of U.S. 5,387,603 Kitazawa et al ('603)

Compound 40 disclosed at cols. 49-50 of '603 with IR, Specific Rotation and NMR data being given, has the same structural formula as KMD-3213.

However, as can be seen from Experiments 1 and 2 at pages 4-5 of the Tsuru Declaration (filed Declaration executed 12/18/06, filed 12/27/06), the IR data for Com. 40 at cols. 49/50 of '603 shows the β or an amorphous form of KMD-3213.

Thus, '603, a family member of Literature 1 disclosed in the present specification at page 9, lines 4 to 5, discloses a preparation method for crude crystals of KMD-3213 which are a starting material used in the present application.

Applicants clearly teach in the specification that KMD-3213 is a known compound and, for example, can be prepared by the procedure described in the above '603, family member of Literature 1. Referring to '603, family member of Literature 1, namely Example 1 at column 42, line 20-46, and specifically at line 39, it is seen that the product was "an amphorus powder". Referring to '603 at column 42, lines 47-15, namely Example 2, in a manner similar to that described in Example 1, the "following compounds" were prepared. Referring to columns 49/50 of '603, namely Com. 40, that is KMD-3213, as one of the "following compounds".

Taking this starting material, and following the procedure of Example 1 in the present application, one can form the α form crystals of KMD-3213, the claimed product.

Turning now to the present specification at page 11, Example 1, which corresponds to the '374 publication at paragraph [0044], this teaches as follows for preparation of the crystal form α:

"To 1 g of crude crystals of KMD-3213 was added 3 mL of ethyl acetate, and the mixture was heated to dissolve. After insoluble material were filtered off, the filtrate was allowed to stand at room temperature. After completion of precipitation of the resulting crystals, 10 mL of ethyl acetate was added thereto. The resulting crystals were collected by filtration, and dried at 50°C for 16 hours in vacuo to give 930 mg of the crystal form α."

Thus, Example 1 of the present application teaches how to take the crude crystals of KMD-3213 formed in Literature 1, which corresponds to '603 (same family), and thus one of ordinary skill in the art was enabled to make the starting material or crude crystals of KMD-3213, β-form or amorphous, and from Example 1 is enabled to make the α form.

Applicants submit that, properly construed, the present specification, as of its filing date enables one of ordinary skill in the art to make the α form without undue experimentation.

Specifically, once one has the "starting material" following the procedure of '603 (family member of Literature 1), one then follows Example 1 at page 11 of the present specification, to heat to dissolve, filter off insolubles, allow to stand at room temperature, after completion of precipitation of the resulting crystals add ethyl acetate, collect by filtration and dry for 16 hours in vacuo to obtain crystal form α.

Withdrawal of the rejection and allowance is requested.

Enablement

On the issue of enablement and any "secrecy", insofar as enablement is concerned, the issue of "secrecy" does not go to the issue of enablement.

Applicants have earlier explained how the present specification, considering the teaching of '603, family member of Literature 1, contains a teaching of how to obtain the starting material used in Example 1 to obtain the **claimed** α crystal form.

Applicants have also explained the procedure of Example 1 which is used to treat the starting material β or amorphous crystal form from '603 (family member of Literature 1) and obtain the **claimed** α form. In this regard, Applicants are **not claiming** the β or amorphous form.

The Law

A case of non-enablement can be made if Applicants fail to disclose any mode which enables one of ordinary skill in the art to practice the invention. *In re Glass*, 492 F.2d 1228, 1233, 181 USPQ 31, 35 (CPA 1974). *Glass* was cited with approval in *Spectra-Physics Inc. v. Coherent Inc.*, 827 F.2d 1524, 3 USPQ2d 1737 (Fed. Cir. 1987). This is not, however, the case here.

The enablement requirement is met if the description enables any mode of making and using the **claimed invention**. See *Engel Industries Inc. v. The Lockformer Co.*, 946 F.2d 1528, 20 USPQ 1300 (Fed. Cir. 1991). *Engel* was cited with approval in *The John Hopkins University v. Cellpro Inc.*, 152 F.3d 1342, 47 USPQ2d 1705 (Fed. Cir. 1998).

Finally, as the Federal Circuit has stated:

"The law makes clear that the specification need only teach one mode of making and using a claimed composition." See *Amgen Inc. v. Hoechst Marion Roussel Inc.*, 314 F.3d 1313, 65 USPQ2d 1385 (Fed. Cir. 2003).

The invention relates to the α form. It does not relate to a process of making the α form. It does not relate to the starting material taught as formed in '603 (family member of Literature 1).

Applicants respectfully submit they quite clearly enable one, based on the present specification, to form the α form crystals of KMD-3213.

All the law requires is that the specification teach one mode of making and using, and that is what Applicants have done.

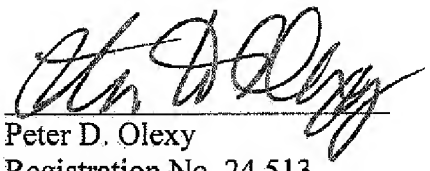
The issue of "secrecy " ("the process for making the compound that was kept secret") is, for purposes of enablement, not a facture to consider of the specification otherwise enables. The present specification here otherwise enables.

As earlier indicated if the Examiner would like a full translation of Literature 1, or any other material, it is it is believed the same can be provided.

Withdrawal of the rejection and allowance is requested.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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